



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF APPEALS AND INTERFERENCES

Application of Mikhail Lotvin and Richard M. Nemes

Appl. No.: 10/790,991

Filed: 03/02/2004

Title: Computer systems and methods supporting on-line interaction with content, purchasing, and searching

Group/Art Unit: 3622

Examiner: BOVEJA, NAMRATA

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APPEAL BRIEF

This is an appeal from the Final Rejection of the Examiner dated 01/26/09 finally rejecting claims 27, 28, 75-77, 79-85 of the above application. A notice of Appeal was filed June 24, 2009 with a petition for extension of time and required fee.

The fee required for the filing of this brief in support of an appeal is \$270. Appellants properly claim small entity status. A check for \$270 is enclosed herewith.

A petition for extension of time (3 months) is filed concurrently herewith along with another check for \$555. Appellants properly claim small entity status.

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REAL PARTY IN INTEREST

Same as the inventors in the caption of this application: Mikhail Lotvin and
Richard M. Nemes

RELATED APPEALS AND INTERFERENCES

None

STATUS OF CLAIMS

Claims 27, 28, 75-77, 79-85 are pending in this application, and are finally rejected. The final rejection of claims 27, 28, 75-77, 79-85 is appealed herein.

Claims 1-26, 29-74, 78 have been canceled without prejudice.

STATUS OF AMENDMENTS

All the amendments have been entered by the Examiner. There are no outstanding un-entered amendments in this case.

SUMMARY OF CLAIMED SUBJECT MATTER

A. CLAIM 27 - INEPENDENT

One embodiment of the invention (see, e.g. claim 27) is a method of providing advertisement to a user communicating with an advertising entity over a network. (See, e.g., page 19, line 25 – page 20 line 19; Fig. 19). The method includes sending e-mail comprising an advertisement message identifying the advertised product or service and a monetary value associated with the advertisement. (See, e.g., page 19, line 25 – page 20 line 13; Fig. 19). The monetary value associated with the advertisement and the identification of the advertised product or service are displayed in a subject line of the transmitted e-mail, which is displayed to the user before the e-mail is opened and a message in a body of the e-mail can be read (See, e.g., page 20, line 4 – page 20 line 13; Fig. 19). If the user opens the email, the automatically-generated response from computer of the user indicating that the user has opened the e-mail is received. (See, e.g., page 20, line 13 – page 20 line 18; Fig. 19). After receiving the response indicating that the e-mail has been opened, the user is enabled to realize the monetary value associated with the advertisement. (See, e.g., page 20, line 18 – page 20, line 24, Fig. 19). The user is provided with purchasing choices consistent with the monetary value (See, e.g., page 25, line 1 – page 25, line 12, Fig. 6). The method further includes electronically determining the user's selection of one or more of such purchasing choices, and electronically providing the user's selection to a third-party supplier of goods or services selected by the user. (See, e.g., page 25, line 13 – page 25, line 19, Fig. 6).

B. CLAIM 80 – INEPENDENT

One embodiment of the invention (see, e.g., claim 80) provides computer readable medium storing instructions that when executed cause a computer system to perform the steps described below. (See, e.g., page 8, line 30 – page 9 line 12; Figs. 1, 6, 12A, 13, 14, 19). The steps include sending e-mail comprising an advertisement message identifying the advertised product or service and identifying a monetary value associated with the advertisement. (See, e.g., page 19, line 25 – page 20 line 13; Fig. 19). The monetary value associated with the advertisement and the identification of the advertised product or service are displayed in the subject line of the transmitted e-mail, which is displayed to the user before the e-mail is opened and a message in a body of the e-mail can be read (See, e.g., page 20, line 4 – page 20 line 13; Fig. 19). If the user opens the email, the automatically-generated response from computer of the user indicating that the user has opened the e-mail is received. (See, e.g., page 20, line 13 – page 20 line 18; Fig. 19). After receiving the response indicating that the e-mail has been opened the user is enabled to realize the monetary value associated with the advertisement. (See, e.g., page 20, line 18 – page 20, line 24, Fig. 19). The user is provided with purchasing choices consistent with the monetary value (See, e.g., page 25, line 1 – page 25, line 12, Fig. 6). The method further includes electronically determining the user's selection of one or more of such purchasing choices and electronically providing the user's selection to a third-party supplier of goods or services consistent with the user's selection. (See, e.g., page 25, line 13 – page 25, line 19, Fig. 6).

C. MEANS PLUS FUNCTION AND STEP PLUS FUNCTION LIMITATIONS

Presently, it is believed that, there are no means plus function and step plus function limitations in the independent claims or dependent claims argued separately.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Rejection of Claims 27, 75, 77, 79-81, 83, 84 under USC 103(a) as being unpatentable over Kamakura, et al. US Patent Number 6,076,101 (hereinafter "Kamakura") in view of the article by Shannon Obendorf, titled "Points for Loyalty" from Catalog Age December 1997, Vol. 14 Iss. 13 pg. 35 (hereinafter "Obendorf") and further in view of Official Notice.

Rejection of Claims 28 and 85 under USC 103(a) as being unpatentable over Kamakura in view of Obendorf and further in view of Official Notice and further in view of the Valupage.com website (www.valuepage.com) from date 12/03/1998 captured by the Wayback Internet Archive (hereinafter "Valupage").

Rejection of Claims 76 and 82 under USC 103(a) as being unpatentable over Kamakura in view of Obendorf and further in view of Official Notice and further in view of Goldhaber, et al. US Patent Number 5855008 (hereinafter Goldhaber).

ARGUMENT

The Examiner's rejection of the pending claims should be reversed because the cited references do not establish the *prima facie* obviousness of the pending claims.

Obviousness:

"[T]he legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process." MPEP (8th ed.), §2142. "The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." *Id.*

To establish obviousness prior art should at least suggest all of the features of a claim since "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval)." *Id.* "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)." MPEP (8th ed.), § 2143.03.

"A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)" MPEP (8th ed.), § 2143.03

In the present case, the Examiner's attempt to establish the *prima facie* obviousness of the pending claims fails to meet all the requirements, as discussed in detail below.

Official Action:

"The standard of review applied to findings of fact is the "substantial evidence" standard under the Administrative Procedure Act (APA)" MPEP § 2144.03.

"Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. **While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113.** Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are **capable of instant and unquestionable demonstration as being well-known.** As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be **"capable of such instant and unquestionable demonstration as to defy dispute"** (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961))." MPEP § 2144.03(A) (Emphasis added). The same section of the MPEP suggests that the use of Official Notice may be a more reasonable in connection with dependent claims. MPEP § 2144.03(A)

"It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are **not capable of instant and unquestionable demonstration as being well-**

known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. ... *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.")." MPEP § 2144.03(A) (Emphasis added).

The Office Action at issue includes Official Notices lacking documentary support, including such Notice provided for the first time in the final rejection despite the express discouragement to do so in the MPEP as quoted above. As will be further discussed below, applicants traverse such notices as not meeting the above requirements. One of the notices was presented before the final rejection. Applicants directly and specifically traversed it in the immediately following amendment, but in the subsequent Office Action, Examiner again repeated the same notice without providing documentary support.

Generally in this augment:

Nothing in this argument (and anywhere else in this document) should be construed as acquiescence with Examiner's position or as an admission, even when it is not necessary to dispute certain points in the Office Action in order to establish patentability. Not expressly disputing Examiner's statement or reasoning should not be construed as Applicants' acquiescence.

Unless otherwise specified, all the references to statements by the Examiner or to the Office Action relate to the Office Action mailed 01/26/09 finally rejecting the claims at issue.

A. REJECTION OF CLAIMS 27, 75, 77, 79-81, 83, 84 UNDER USC 103(A) AS BEING UNPATENTABLE OVER KAMAKURA IN VIEW OF OBENDORF AND FURTHER IN VIEW OF OFFICIAL NOTICE.

Independent Claims 27 and 80 (including all the pending claims since the remaining claims are dependent on 27 and 80).

The independent claims have been rejected through a combination of two references and two Official Notices. At the outset, the rejection looks like an exercise in hindsight, since so many separate pieces had to be put together to make the obviousness argument.

Examiner uses Official Notices for two limitations of the independent claims. One Official Notice relates to the limitation of “identifying advertised product or service” and, consequently, displaying the advertised product or service along with the monetary value associated with the e-mail in the subject line of the transmitted e-mail. In the final rejection, Examiner also introduces the second Official Notice for the limitation of “receiving an automatically-generated response from computer of the user indicating that the user has opened the e-mail.” Examiner’s observations in these Notices relate to the current state of the art and they do not address the state of the art before the effective filing date of the present application, which is at issue. To make the allegations in the Official Notices relevant to this application, documentary proof was necessary to illustrate that what Examiner claims to be old and well-known was in fact known at the relevant time.

However, the Official Notices avoid referring to either dates or documents. Since the Official Notices do not address the state of the art and skill in the art at the appropriate timeframe and include no documentary support, they are improper and should not be considered as teaching or suggesting claim limitations.

The independent claims are also limited to “electronically providing the user with purchasing choices consistent with the monetary value; electronically determining the user’s selection; and electronically providing the user’s selection to a third-party supplier of goods or services consistent with the user’s selection.” Examiner asserts that the Obendorf reference teaches these steps.

The Obendorf reference describes the MyPoints system that manages reward points but it is not part of the purchasing process that uses the points. As explained in last sentence of paragraph 4 of Obendorf “A proprietary search engine within the MyPoints site directs consumers to Websites that issue and redeem points.” Consequently, the MyPoints site does *not* offer purchasing selections which, when made, are fulfilled at a third party provider. As described in paragraph 5 of Obendorf, the entire transaction (including offering a user selection and providing the selected goods) is conducted by the “catalog participants.” Consequently, nowhere in the Obendorf reference there is a teaching of all 3 steps of (1) electronically providing the user with purchasing choices consistent with the monetary value; (2) electronically determining the user’s selection; and (3) electronically providing the user’s selection to a third-party supplier of goods or services consistent with the user’s selection.

For the foregoing reasons, claims 27 and 80 and all the claims dependent therefrom are patentable.

B. REJECTION OF CLAIMS 28 AND 85 UNDER USC 103(A) AS BEING UNPATENTABLE OVER KAMAKURA IN VIEW OF OBENDORF AND FURTHER IN VIEW OF OFFICIAL NOTICE AND FURTHER IN VIEW OF VALUPAGE.

Dependent claims 28 and 85 further limit the e-mail advertisement steps of the independent claims to “specifying an expiration date after which the monetary value associated with the advertisement expires.” Examiner asserts that the Valupage reference teaches this limitation and that it can be combined with two publications and two Official Notices applied against the independent claims. This argument fails for a variety of reasons.

The Valupage reference shows a website that apparently sells goods. The website displays text stating the aggregate amount of saving available through this site in a given week in connection with several leading brands. It cannot be combined with the e-mail-related Kamakura reference, which essentially teaches against such a combination. Kamakura’s approach is personal and the goal of his system would not be fulfilled by a generalize website such as Valupage. Kamakura asserts that the disclosed method stands out because it allows soliciting and receiving a personal response from a user. See, e.g., col. 10 lns. 18-24 of Kamakura, which state: “Actually, since the recipients are rewarded with those bonus points only when they have replied to the e-mail message, the original sender can expect the reply messages to return at a higher probability. Through this process, the original sender can successfully make access to the recipients and achieve firm communication with them.” Consequently, a passive website as in Valupage contradicts the very reason for Kamakura’s system and therefore these references cannot be combined.

Further, the Valupage reference does not imply any expiration date. The fact that in a given week in aggregate \$42 in saving is available does not mean that the discount is good for one week and that it would not be available in the next week. It is possible that in the next week the discount will be the same or increased because the same products will remain on sale and other products may be offered at a discount as well. The weekly announcement does not imply at all any deadline on the available discount, or that there would be no discounts after one week, or that there would not be a discount for the products presently sold at discount. Accordingly, the Valupage reference cannot be construed as "specifying an expiration date."

In addition to the patentability of the independent claims, for these additional reasons claims 28 and 85 are patentable.

**C. REJECTION OF CLAIMS 76 AND 82 UNDER USC 103(A) AS
BEING UNPATENTABLE OVER KAMAKURA IN VIEW OF OBENDORF AND
FURTHER IN VIEW OF OFFICIAL NOTICE AND FURTHER IN VIEW OF
GOLDHABER**

Without prejudice and without acquiesce to Examiner's position, to simplify this Appeal, dependent claims 76 and 82 are patentable for the reasons set forth in connection with the patentability of their respective independent claims.

D. CLAIMS NOT SEPARATELY ARGUED

Without conceding that they lack patentably distinguishing limitations, appellants acknowledge that, for purposes of this appeal, dependent claims not separately argued stand or fall with the separately-argued claim that they depend on.

CONCLUSION

As demonstrated above the rejected claims are patentable.

Appellants respectfully request that the Examiner's rejection of claims 27, 28, 75-77, 79-85 be reversed.

Respectfully submitted,

November 22, 2009


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CLAIMS APPENDIX

Claim 27. A method of providing advertisement to a user communicating with an advertising entity over a network, comprising: sending e-mail comprising an advertisement message identifying a monetary value associated with the advertisement and identifying advertised product or service, wherein the monetary value and advertised product or service are displayed in a subject line of the transmitted e-mail, which is displayed to the user before the e-mail is opened and a message in a body of the e-mail can be read; receiving an automatically-generated response from computer of the user indicating that the user has opened the e-mail; and enabling the user to realize the monetary value associated with the advertisement, comprising the steps of: electronically providing the user with purchasing choices consistent with the monetary value; electronically determining the user's selection; and electronically providing the user's selection to a third-party supplier of goods or services consistent with the user's selection.

Claim 28. The method of claim 27 further comprising specifying an expiration date after which the monetary value associated with the advertisement expires.

Claim 75. The method of claim 27 further comprising transferring the monetary value specified in the e-mail to account of the user.

Claim 76. The method of claim 27 wherein the monetary value is displayed as currency.

Claim 77. The method of claim 27 wherein the monetary value is displayed as points.

Claim 79. The method of claim 27 further comprising electronically receiving a commission from the third-party supplier of goods or services.

Claim 80. A computer readable medium storing instructions that when executed cause a computer system to perform the steps comprising: sending e-mail to computer of a user comprising an advertisement message identifying a monetary value associated with an advertisement and identifying advertised product or service, wherein the monetary value and advertised product or service are displayed in a subject line of the transmitted e-mail, which is displayed to the user before the e-mail is opened and a message in a body of the e-mail can be read; receiving an automatically-generated response from computer of the user indicating that the user has opened the e-mail; and enabling the user to realize the monetary value associated with the advertisement, comprising the steps of: electronically providing the user with purchasing choices consistent with the monetary value; electronically determining the user's selection; and electronically providing the user's selection to a third-party supplier of goods or services consistent with the user's selection.

Claim 81. The computer readable medium of claim 80 further including instructions for transferring the monetary value specified in the e-mail to account of the user.

Claim 82. The computer readable medium of claim 80 wherein the monetary value is displayed as currency.

Claim 83. The computer readable medium of claim 80 wherein the monetary value is displayed as points.

Claim 84. The computer readable medium of claim 80 further including instructions for electronically receiving a commission from the third-party supplier of goods or services.

Claim 85. The computer readable medium of claim 80 further comprising instruction for specifying an expiration date after which the monetary value associated with the advertisement expires.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.